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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400

PATENT APPLICATIONATTORNEY DOCKET NO. 60004065-4

**IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE**

Inventor(s): Alex Roche

Confirmation No.: 7580

Application No.: 10/088,715

Examiner: William J. Allen

Filing Date: March 19, 2002

Group Art Unit: 3625

Title: Method and Apparatus for Automated On-Line Printing Service

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEFTransmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on June 13, 2008.

- The fee for filing this Appeal Brief is \$510.00 (37 CFR 41.20).
 No Additional Fee Required.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

- (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:

 1st Month
\$120 2nd Month
\$480 3rd Month
\$1050 4th Month
\$1640

- The extension fee has already been filed in this application.

- (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of \$ 510. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees.

- A duplicate copy of this transmittal letter is enclosed.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:
Commissioner for Patents, Alexandria, VA 22313-1450
Date of Deposit:

Respectfully submitted,

Alex Roche

By

Dan C. Hu

Attorney/Agent for Applicant(s)

Reg No. : 40,025

Date : August 13, 2008

Telephone : (713) 468-8880, ext. 304

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Date of facsimile: August 13, 2008

Typed Name: Ginger Yount

Signature:

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Alex Roche	§ Art Unit:	3625
Serial No.:	10/088,715	§	
Filed:	March 19, 2002	§ Examiner:	William J. Allen
For:	Method and Apparatus for Automated On-Line Printing Service	§ Atty. Dkt. No.:	60004065-4 (HPC.0541US)
		§	

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF PURSUANT TO 37 C.F.R § 41.37

Sir:

The final rejection of claims 1 and 63-73 is hereby appealed.

I. REAL PARTY IN INTEREST

The real party in interest is Hewlett-Packard Development Company, L.P.

II. RELATED APPEALS AND INTERFERENCES

None.

III. STATUS OF THE CLAIMS

Claims 1 and 63-73 have been finally rejected and are the subject of this appeal. Claims 2-62 and 74-77 have been cancelled.

Date of Deposit: August 13, 2008

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Ginger Yount
Ginger Yount

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IV. STATUS OF AMENDMENTS

An Amendment Under 37 C.F.R. § 41.33 has been submitted to cancel claims 74-77, and to address a minor formal matter. Entry of the Amendment is proper.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

The following provides a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings by reference characters, as required by 37 C.F.R. § 41.37(c)(1)(v). Each element of the claims is identified by a corresponding reference to the specification and drawings where applicable. Note that the citation to passages in the specification and drawings for each claim element does not imply that the limitations from the specification and drawings should be read into the corresponding claim element.

Independent claim 1 recites a method of operating an on-line retailing operation for selling a plurality of print products to a plurality of retail and business customers, said print products supplied by at least one print merchant, said method comprising the steps of:

displaying a plurality of image items for on-line viewing by said retail customers at a content retailer web site operated by or for a content retailer, said plurality of image items being made available to said content retailer for public merchandizing at said content retailer web site by at least one third party content provider (Spec., p. 14, lines 16-27; p. 28, lines 5-6);

offering a direct service to business customers for generating and ordering print products out of their own content (Spec., p. 15, lines 16-28);

transacting orders of a first type between said retail customers and said content retailer for supply at least one print product based on said customers ordering at least one print product after viewing at least one of said image items at said content retailer web site, wherein the at least one print product includes at least one of said image items made available for merchandizing by said at least one third party content provider (Spec., p. 22, lines 18-23);

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transacting orders of a second type between

(i) said content retailer and said print merchant for fulfillment of said first type order by said print merchant (Spec., p. 23, line 29-p. 24, line 6; p. 24, lines 27-28); and

(ii) said business customers and said print merchant for fulfillment of business customer orders by said print merchant (Spec., p. 15, lines 25-28); and

transacting an order of a third type between said print merchant and a print service provider for printing and shipping said at one print product to either said retail customers or said business customers on the basis of the print product ordered by the retail or business customer (Spec., p. 30, line 26-p. 31, line 2).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

- A. **Claims 1, 63, 64, 67, 68, 72, and 73 Rejected Under 35 U.S.C. § 103(a) as Unpatentable Over U.S. Patent No. 6,133,985 (Garfinkle) in View of U.S. Patent No. 6,493,677 (von Rosen), and Further in View of PTO Form 892, Reference V (MediaFlex).**
- B. **Claims 65 and 66 Rejected Under 35 U.S.C. § 103(a) as Unpatentable Over Garfinkle in View of von Rosen and MediaFlex, and Further in View of U.S. Patent Application Publication No. 2003/0140315 (Blumberg).**
- C. **Claim 69 Rejected Under 35 U.S.C. § 103(a) as Unpatentable Over Garfinkle in View of von Rosen and MediaFlex, and Further in View of U.S. Patent No. 6,016,504 (Arnold).**
- D. **Claims 70 and 71 Rejected Under 35 U.S.C. § 103(a) as Unpatentable Over Garfinkle in View of von Rosen, MediaFlex, Arnold, and Further in View of PTO Form 892, Reference U.**

VII. ARGUMENT

The claims do not stand or fall together. Instead, Appellant presents separate arguments for various independent and dependent claims. Each of these arguments is separately argued below and presented with separate headings and sub-headings as required by 37 C.F.R. § 41.37(c)(1)(vii).

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A. **Claims 1, 63, 64, 67, 68, 72, and 73 Rejected Under 35 U.S.C. § 103(a) as Unpatentable Over U.S. Patent No. 6,133,985 (Garfinkle) in View of U.S. Patent No. 6,493,677 (von Rosen), and Further in View of PTO Form 892, Reference V (MediaFlex).**

1. **Claims 1, 63, 64, 67, 68, 73.**

Independent claim 1 was rejected as purportedly obvious over Garfinkle, von Rosen, and MediaFlex. It is respectfully submitted that the obviousness rejection is defective, since no reason existed that would have prompted a person of ordinary skill in the art to combine the teachings of these references. *See International Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1741, 82 U.S.P.Q.2d 1385 (2007).

The Examiner conceded that Garfinkle fails to disclose the “transacting an order of a third type” clause of claim 1 – however, the Examiner cited von Rosen as purportedly disclosing this claim feature. 3/19/2008 Office Action at 6. The Examiner also conceded that Garfinkle fails to disclose the following features of claim 1:

- “offering a direct service to business customers for generating and ordering print products out of their own content”; and
- “said plurality of image items being made available to said content retailer for public merchandizing at said content retailer web site by at least one third party content provider.”

Id. at 7.

The Examiner argued that these features are “old and well known in the art of providing printing services,” and cited MediaFlex as purportedly supporting such statement. *Id.*

The combination of references made by the Examiner is erroneous. First, it is noted that Garfinkle relates to a system that allows a photographer to provide photographic film for scanning at a scanning center 14, which then acquires a digital image of the photographic images of the photographic film and stores such images on image servers 16. Garfinkle, 2:60-3:4. The

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photographer 8 then is able to access images (displayed in the form of thumbnails) to allow the photographer to order a visual print of the photographic images. *Id.*, 5:16-34; 7:5-17.

Thus, Garfinkle contemplates a process in which photographic images are acquired through scanning of photographic films and uploading such photographic images to image servers, and subsequently allowing a photographer access of such images so that the photographer can order prints from such images.

The teachings of Garfinkle are inconsistent with the teachings of MediaFlex. The Examiner argued that MediaFlex discloses a mechanism to offer a direct service to business

PAGE 7/7 * RCVD AT 8/13/2008 2:48:37 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-4/21 * DNIS:2738300 * CSID:7134688883 * DURATION (mm:ss):09:18

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photographer 8 then is able to access images (displayed in the form of thumbnails) to allow the ~~photographer~~ to order a visual print of the photographic images. *Id.*, 5:16-34; 7:5-17.

Thus, Garfinkle contemplates a process in which photographic images are acquired through scanning of photographic films and uploading such photographic images to image servers, and subsequently allowing a photographer access of such images so that the photographer can order prints from such images.

The teachings of Garfinkle are inconsistent with the teachings of MediaFlex. The Examiner argued that MediaFlex discloses a mechanism to offer a direct service to business customers for generating and ordering print products out of their own content. However, this teaching of MediaFlex is inapplicable to the system of Garfinkle, which requires that a developer, scanning center, and image servers be made available to photographers so that photographic images taken by such photographers are made available to the photographer. Garfinkle provides absolutely no hint that it would be beneficial to allow the photographers direct access to an on-line print center, as disclosed in item 1 on page 3 of MediaFlex. In fact, providing direct access to an on-line print center by a photographer, as suggested by MediaFlex, would render the Garfinkle system inoperable for its intended purpose, since Garfinkle requires that a developer, scanning center, and image servers be provided to allow for development of photographic images from photographic film and scanning of such film at a scanning center for storage on image servers. Even in the embodiment in which a digital camera is used, Garfinkle teaches that the digital image from the digital camera has to be uploaded directly to image servers 16 for later access by the photographer for ordering prints.

Since modifying Garfinkle with the teachings of MediaFlex would render Garfinkle inoperable for its intended purpose, that is an indication that no reason existed that would have

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prompted a person of ordinary skill in the art to combine the teachings of Garfinkle, von Rosen, and MediaFlex.

In view of the foregoing, it is respectfully submitted that the obviousness rejection of claim 1 and its dependent claims is erroneous.

Reversal of the final rejection of the above claims is respectfully requested.

2. Claim 72.

Claim 72 depends from claim 1, and is therefore allowable for at least the same reasons as claim 1.

Moreover, claim 72 recites that the steps of transacting orders of a second type with a print merchant comprises: "itemizing separately, for each of a plurality of print service providers; a delivery price for delivery from said print service provider to a delivery address; and a print price, for printing at least one print product, defined in said second order type."

The Examiner cited Figs. 10A-11B of von Rosen as purportedly disclosing this feature of claim 72. These figures of von Rosen depict a checkout web page 200 (Figs. 10A-10B) and a confirmation web page 202 (Figs. 11A-11B). The checkout web page 200 receives a consumer's billing address and shipping address, and for receiving payment information from the consumer. von Rosen, 10:47-54. The confirmation web page 202 displays a summary of the consumer's order, including the short description of the order, order date, order time, billing address, shipping address, order quantity and type, and credit card information. *Id.*, 10:59-63. However, there is absolutely no teaching or hint here of itemizing separately, for each of a plurality of **print service providers**, a delivery price for delivery from the print service provider to a delivery address. Claim 72 specifically calls for a plurality of print service providers and an

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itemization of delivery prices for such print service providers. No teaching or hint of this claim feature is provided by any of the cited references.

Therefore, claim 72 is further allowable for the foregoing reason.

Reversal of the final rejection of the above claim is respectfully requested.

B. Claims 65 and 66 Rejected Under 35 U.S.C. § 103(a) as Unpatentable Over Garfinkle in View of von Rosen and MediaFlex, and Further in View of U.S. Patent Application Publication No. 2003/0140315 (Blumberg).

1. Claims 65, 66.

In view of the defective obviousness rejection of base claim 1 over Garfinkle, von Rosen, and MediaFlex, it is respectfully submitted that the obviousness rejection of dependent claims 65 and 66 over Garfinkle, von Rosen, MediaFlex, and Blumberg is also defective.

Reversal of the final rejection of the above claims is respectfully requested.

C. Claim 69 Rejected Under 35 U.S.C. § 103(a) as Unpatentable Over Garfinkle in View of von Rosen and MediaFlex, and Further in View of U.S. Patent No. 6,016,504 (Arnold).

1. Claim 69.

In view of the defective obviousness rejection of base claim 1 over Garfinkle, von Rosen, and MediaFlex, it is respectfully submitted that the obviousness rejection of dependent claim 69 over Garfinkle, von Rosen, MediaFlex, and Arnold is also defective.

Reversal of the final rejection of the above claim is respectfully requested.

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- D. **Claims 70 and 71 Rejected Under 35 U.S.C. § 103(a) as Unpatentable Over Garfinkle in View of von Rosen, MediaFlex, Arnold, and Further in View of PTO Form 892, Reference U.**

1. Claims 70, 71.

In view of the defective obviousness rejection of base claim 69 over Garfinkle, von Rosen, MediaFlex, and Arnold, it is respectfully submitted that the obviousness rejection of claims 70 and 71 over Garfinkle, von Rosen, MediaFlex, Arnold, and PTO 892, Reference U is also defective.

Reversal of the final rejections of the above claims is respectfully requested.

CONCLUSION

In view of the foregoing, reversal of all final rejections and allowance of all pending claims is respectfully requested.

Respectfully submitted,

Date: Aug 13, 2008


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VIII. APPENDIX OF APPEALED CLAIMS

The claims on appeal are:

1 1. A method of operating an on-line retailing operation for selling a plurality of print
2 products to a plurality of retail and business customers, said print products supplied by at least
3 one print merchant, said method comprising the steps of:

4 displaying a plurality of image items for on-line viewing by said retail customers at a
5 content retailer web site operated by or for a content retailer, said plurality of image items being
6 made available to said content retailer for public merchandizing at said content retailer web site
7 by at least one third party content provider;

8 offering a direct service to business customers for generating and ordering print products
9 out of their own content;

10 transacting orders of a first type between said retail customers and said content retailer
11 for supply at least one print product based on said customers ordering at least one print product
12 after viewing at least one of said image items at said content retailer web site, wherein the at
13 least one print product includes at least one of said image items made available for
14 merchandizing by said at least one third party content provider;

15 transacting orders of a second type between

16 (i) said content retailer and said print merchant for fulfillment of said first
17 type order by said print merchant; and

18 (ii) said business customers and said print merchant for fulfillment of business
19 customer orders by said print merchant; and

20 transacting an order of a third type between said print merchant and a print service
21 provider for printing and shipping said at one print product to either said retail customers or said
22 business customers on the basis of the print product ordered by the retail or business customer.

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1 63. The method as claimed in claim 1, wherein said step of transacting an order of a first type
2 comprises:

3 receiving a specification of said print products from said customer, said specification
4 comprising data selected from the set including: media size; media type; number of copies;
5 delivery name; delivery address; ink type.

1 64. The method as claimed in claim 63, wherein said step of transacting an order of a first
2 type comprises receiving a specification of said print products from a customer terminal, in the
3 form of an electronically transmitted data file.

1 65. The method as claimed in claim 1, wherein said step of transacting an order of a second
2 type comprises the steps: sending an order to said print merchant, specifying details of said print
3 products; and receiving confirmation of said order from said print merchant.

1 66. The method as claimed in claim 65, wherein said step of sending an order to a said print
2 merchant comprises sending said order in the form of an electronically transmitted data file.

1 67. The method as claimed in claim 1, further comprising the step of: receiving a price data
2 from said print merchant.

1 68. The method as claimed in claim 1, further comprising the step of: obtaining an electronic
2 image data describing a said image item; said electronic image data obtained via a
3 communications network; and electronically sending said electronic image data to said print
4 merchant.

1 69. The method as claimed in claim 1, further comprising the step of: storing an electronic
2 contract data describing a contract between a content retailer operation and a print merchant
3 operation.

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1 70. The method as claimed in claim 69, wherein said contract defines a relationship between
2 said content retailer operation and said print merchant operation in respect of at least one of the
3 following parameters; a definition of a print product; a special discount available to a content
4 retailer operation; a plurality of prices for said print products.

1 71. The method as claimed in claim 69 comprising the step of calculating a price data
2 according to said stored electronic contract.

1 72. The method as claimed in claim 1, wherein said step of transacting an order of a second
2 type with a said print merchant, comprises: itemizing separately, for each of a plurality of print
3 service providers; a delivery price for delivery from said print service provider to a delivery
4 address; and a print price, for printing at least one print product, defined in said second order
5 type.

1 73. The method as claimed in claim 1, wherein said step of transacting an order of a first type
2 with said customer comprises: for each of a plurality of print products: displaying a print
3 product price; and displaying a separately itemized delivery cost for delivery of said print
4 product.

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IX. EVIDENCE APPENDIX

None.

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X. RELATED PROCEEDINGS APPENDIX

None.